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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/009,014   | 11/30/2001  | Robert D Fish        | 323.09-US1          | 2166             |
| 34284  | 7590        | 06/29/2004           | EXAMINER            |                  |
| ROBERT D. FISH; RUTAN & TUCKER, LLP<br>P.O. BOX 1950<br>611 ANTON BLVD., 14TH FLOOR<br>COSTA MESA, CA 92628-1950 |             |                      | LE, UYEN T          |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2171                |                  |
| DATE MAILED: 06/29/2004  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                  |
|------------------------------|------------------------|------------------|
| <b>Office Action Summary</b> | Application No.        | Applicant(s)     |
|                              | 10/009,014             | FISH, ROBERT D   |
|                              | Examiner<br>Uyen T. Le | Art Unit<br>2171 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 08 April 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

|   |  |
|---|--|
| <ol style="list-style-type: none"> <li>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date _____.</li> </ol> | <ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol> |
|---|--|

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's arguments regarding claims 1-21 have been fully considered but they are not persuasive.

Regarding claims 1, 18, 21, applicant argues that "a "matter management system" must at the very least include matter identifiers and textual hours entries corresponding to those matters". In response, although claims are interpreted in light of the specification, the specification cannot be read into the claims. Therefore, the "matter management system" as broadly claimed reads on the system of Tomiyasu that includes a matter specific timer based reminder mechanism (see the abstract).

Regarding claims 2-11, 13-17, 20, applicant argues that "the only cited reference is Tomiyasu and that reference is missing almost all the elements of all the elements of the claims". In response, applicant fails to recognize the capability of one of ordinary skill in the art. One of ordinary skill in the art knows something about the art apart from what is explicitly shown in a reference and knows how to apply the principles taught in the reference in scenarios not shown in the references. Claim 3 for example merely requires displaying at least three milestones, three hourly billing descriptions, three calendared items. Since the system of Tomiyasu serves a reminder, clearly one of ordinary skill in the art would be motivated to make the system display as many features as required by an application or by the users. Furthermore, claims 2, 4, 5, 7 merely repeat limitations already present in claim 1. Claim 6 merely requires automatic setting of a timer. Claims 8, 9 merely require a scrolling display for one or two identifier/value

pairs. Claims 10, 11 merely require two or three of the features in the group. Claims 13-17 merely recite different data identifiers. None of the claimed limitations distinctly set forth the alleged “invention”.

Applicant argues that Tomiyasu does not even contain the terms “matter” or “hours” or anything equivalent. In response, the examiner disagrees. The abstract and drawings (Figures 5-7, 10, 11) clearly contain “hours”.

It is noted that claim 1 has been amended to add “a program code that records hours records for individual matters”. The system of Tomiyasu is suitable for portable computers (see the title), thus it clearly includes a program code. Furthermore, it serves as a reminder (see the abstract), thus it clearly records hours records for individual matters as claimed.

For all the reasons stated above, rejection to all claims is maintained using the reference of record, hereby repeated.

#### ***Claim Objections***

2. Claims 2, 4, 7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 12, 18, 19, 21 are rejected under 35 U.S.C. 102(a), (e) as being anticipated by Tomiyasu (US 6,134,187).

Regarding claim 1, Tomiyasu discloses a system stored on a computer readable medium comprising a program code that records hours records for individual matters including a matter specific timer based reminder mechanism (see the abstract).

Regarding claim 12, Tomiyasu discloses the claimed method (see Figure 9). The claimed user-defined data identifiers stored on a database are met when Tomiyasu shows Figure 5. The claimed user interface with scrollable listing of identifiers is met by Figure 9. The claimed "selecting a subset...matter", "entering...subset" and "interactively...text data" are met when the user enters the setup screen and selects the desired features (see Figure 9).

Regarding claim 18, the claimed first designation interface is met when Tomiyasu shows that the user selects a year. The claimed second designation interface is met when Tomiyasu shows that the user selects a month. The claimed selection interface is met when Tomiyasu shows that a user selects a date. The claimed interactive display is met by Figure 9. Clearly the listing of all non -selected milestones is not displayed since non-selected items are not of interest to the user.

Regarding claim 19, the selected subset of milestones has to be displayed in the system of Tomiyasu for the user to see what has been selected.

Regarding claim 21, Tomiyashu discloses all the claimed subject matter including a routine that calendars a future task based on a date rule and a count-down timer that is preset by a user or by default (see the abstract, Figures 4-11, columns 2-4).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-11, 13-17, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomiyasu (US 6,134,187).

Regarding claims 2-11, 13-17, although Tomiyasu does not specifically show the claimed features, since the system serves as a reminder, it would have been obvious to one of ordinary skill in the art to include the claimed features depending on users' applications.

Regarding claim 20, since users are not interested in non-selected milestone, it would have been obvious to one of ordinary skill in the art to not display them on the interactive display.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 703-305-4134. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2171

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

25 June 2004



UYEN LE  
PRIMARY EXAMINER